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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL D. RAHN and DAVID B. LECITION

Appeal 2007-3093
Application 09/772,455
Technology Center 2600

Decided: January 30, 2008

Before ANITA PELLMAN GROSS, MAHSHID D. SAADAT, and
ROBERT E. NAPPI *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 6(b) (2002) of the final rejection of claims 36 through 38 and 40 through 49.

We affirm the Examiner's rejections of these claims.

INVENTION

The invention is directed to a docking cradle for use with a Personal Digital Assistant (PDA). The cradle includes an antenna and circuitry to provide wireless communication between the PDA and a host computer.

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See page 3 of Appellants' Specification. Claim 36 is representative of the invention and reproduced below:

36. A cordless method for communication between a host computer and at least one portable communications device using a docking device, wherein the docking device is connectable to the host computer and capable of synchronizing the portable communications device and the host computer when the communications device is docked in the docking device, the method comprising:

communicating a signal between the host computer and the portable communications device through the docking device without docking of the portable communications device in the docking device, using cordless spread spectrum radio technology.

REFERENCES

Whitridge	US 6,119,179	Sep. 12, 2000
Rouphael	US 6,278,725 B1	Aug. 21, 2001
Johnson	US 6,556,826 B1	Apr. 29, 2003

Rejections at Issue

Claims 36 through 38 and 40 through 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Rouphael. The Examiner's rejection is on pages 3 through 5 of the Answer.

Claims 48 and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Rouphael and Whitridge. The Examiner's rejection is on pages 6 and 7 of the Answer.

Throughout the opinion, we make reference to the Brief (received October 17, 2006) and the Answer (mailed December 15, 2006) for the respective details thereof.

ISSUES

Appellants contend that the Office action dated April 23, 2004 was prematurely made final. Brief 7, 8. This relates to a petitionable issue and not an appealable issue. *See In re Schneider*, 481 F.2d 1350, 1356-57, (CCPA 1973) and *In re Mindick*, 371 F.2d 892, 894, (CCPA 1967). *See also* Manual of Patent Examining Procedure (MPEP) (8th Ed., August 2001) § 1002.02(c), item 3(g) and § 1201. Thus, the relief sought by the Appellants would have been properly presented by a petition to the Director under 37 C.F.R. § 1.181 instead of by appeal to this Board. Accordingly, we will not further consider whether the Office action dated April 23, 2004 was properly made final.

On pages 8 through 11 of the Brief, Appellants present arguments directed to the Examiner's rejection of claims 36 through 38 and 40 through 47 under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Rousphael. Appellants' arguments do not separately address the rejected claims. Thus, in accordance with 37 C.F.R. § 41.37(c)(1)(vii), we group the claims together and treat independent claim 36 as the representative claim.

Appellants argue, on page 9 of the Brief, that the Examiner's rejection of claim 36 is in error as the art cited does not teach all of the claimed limitations. Specifically, Appellants assert that the claim recites: a PDA or communication device; a docking device which facilitates communication with a host computer; and a wireless communication link between the PDA and the docking device. Appellants reason that though Johnson teaches a PDA, docking device, and wireless interface, Johnson does not teach using the wireless interface to communicate between the PDA and the host computer. Brief 9, 10. Further, Appellants argue that Rousphael teaches

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using spread spectrum communications technology, but does not teach using this technology to communicate from a PDA to a host computer through a docking device. Brief 10, 11.

Appellants' contentions present us with the issue of whether the Examiner erred in determining that the applied art teaches or suggests "communicating a signal between the host computer and the portable communications device through the docking device without docking of the portable communications device in the docking device, using cordless spread spectrum radio technology" as recited in claim 36.

On pages 11 and 12 of the Brief, the Appellants provide arguments directed to the rejection of claims 48 and 49 under 35 U.S.C. § 103(a). Appellants have not separately argued the claims, thus we group claims 48 and 49 together. See 37 C.F.R. § 41.37(c)(1)(vii). Appellants state, on page 11 of the Brief, that they do not:

[C]laim to have invented the use of handheld devices for conducting chat or email communications. However, nothing in Whitridge teaches or suggests the use of cordless spread spectrum radio technology to provide localized communication, including chat or email, between a handheld device and a host computer via a cradle designed for holding the handheld device, using cordless spread spectrum technology.

Thus, as Appellants admit that they did not invent the use of handheld devices for conducting chat or email communications, the issue before us is the same as discussed above with respect to the claim 36.

PRINCIPLES OF LAW

On the issue of obviousness, the Supreme Court has recently stated that “[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Further, the Court stated “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. at 1739.

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. . . . [A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Id. at 1740. “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 1742.

FINDINGS OF FACT

1. Johnson teaches a communication device which interfaces with a PDA, telephone, computer and data network. The device includes a wireless interface and is configurable to provide data requested from a data network, at user controllable time intervals, to one of the PDA, telephone or computer. Abstract.

2. Johnson teaches that the interface has a docking interface (item 302) and a wireless interface (item 303). See figure 3.
3. The wireless interface creates a wireless link with the PDA, and may use any conventional wireless communication components. Johnson, col. 4, l. 54 – col. 5, l. 3.
4. Johnson teaches that conventional wireless communication paths include spread spectrum links. Col. 1, ll. 37-42.
5. Johnson teaches that the docking interface is configured to receive the PDA and interface the PDA with the computer. Col. 5, ll. 4-7.
6. The docking device can also include the wireless interface. Johnson, col. 5, ll. 11-13.
7. Johnson teaches that the communication device, which includes the docking adaptor, coordinates synchronization of the computer and PDA. Col. 7, ll. 5-10, 25-30.
8. Rousphael teaches that cordless spread spectrum technology was known at the time of the invention. Col. 7, ll. 13-14.

ANALYSIS

Rejection of claims 36 through 38 and 40 through 47 under 35 U.S.C. § 103(a).

Appellants' arguments have not persuaded us that the Examiner erred in determining that the applied art teaches or suggests the PDA communicating with the host computer through the docking device using cordless spread spectrum radio technology, and without docking the PDA, as recited in claim 36. We find that Johnson teaches that there is

communication between the host computer (item 308)¹ and the PDA. Fact 5. This communication is provided by the communication device which connects the docking adaptor interface to the computer system. Fact 7. As the wireless adaptor can be part of the docking adaptor, fact 6, we find Johnson teaches that the docking adaptor provides communications between the PDA and the host computer by either docked connection or wireless connection. Further, Johnson teaches that the wireless connection can be by conventional wireless connection standards and identifies that spread spectrum is a conventional standard. Facts 3 and 4. Roushaphel, likewise, teaches that spread spectrum is a conventional standard for wireless communication. Fact 8. Thus, Appellants have not persuaded us of error in the rejection of representative claim 36 and we affirm the Examiner's rejection of claims 36 through 38 and 40 through 47 under 35 U.S.C. § 103(a).

Rejection of claims 48 and 49 under 35 U.S.C. § 103(a).

As discussed *supra*, Appellants admit that they did not invent the use of handheld devices for conducting chat or email communications. The issue before us related to this rejection is therefore the same as discussed above with respect to the claim 36. As discussed above, Appellants' arguments have not persuaded us that the Examiner erred in determining that the combination of Johnson in view of Roushaphel teaches communicating from a PDA to a host computer via a docking device, using a wireless link.

¹ The Examiner has found computer system, item 308, in Johnson to meet the claimed host computer. We additionally note that the processing system, item 300, in Johnson also appears to meet the limitation of the host processing system as it communicates with the data devices both through the docking station and the wireless link.

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Thus, for the reasons discussed *supra* with respect to the rejection of claims 36 through 38 and 40 through 47 under 35 U.S.C. § 103(a), we affirm the Examiner's rejections of claims 48 and 49 under 35 U.S.C. § 103(a).

ORDER

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KIS

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